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EXAMINER

THOMPSON, JAMES A

ART UNIT PAPER NUMBER

2624

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/024,334

Applicant(s)

RUBINSTENN, GILLES

Examiner

James A. Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/21/2001, 03/10/2003, and 07/27/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/10/03, 7/27/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 9, 18, 27 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9, 18, 27 and 37 each recite "providing a beauty analysis". Since "beauty" is clearly a subjective term, what criteria are being used to provide a "beauty analysis"? Is it the lack of notable blemishes, the particular aspects of skin texture, the level of oiliness in the skin, or one or more other possibilities out of the many potential criteria by which one may analyze "beauty"? "Beauty analysis" is a very imprecise and non-technical term and should thus be amended such that the claim recites the specific criteria that are used in the presently recited "beauty analysis". The recitation of a "beauty analysis" by itself is vague and indefinite, and Applicant has therefore not particularly pointed out and distinctly claimed the subject matter which Applicant regards as the invention.

3. Claim 39 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 39 recites "enabling a subject to print a reference image on a calibrated printer". How is the subject enabled to print the reference image on the calibrated printer? This limitation is not a positive step, but is merely a condition provided for the subject. The positive steps by which a subject would be enabled to print a reference image on a calibrated printer would be a positive recitation of the steps of a method, but the present recitation is vague and imprecise. Thus, Applicant has not particularly pointed out and distinctly claimed the subject matter which Applicant regards as the invention.

Furthermore, claim 39 recites the limitation "the image capture device" in lines 10-11. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 6-8, 10-13, 15-17, 19-22, 24-26, 28-32, 34-36 and 38-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Setchell (US Patent 6,836,345 B1).

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Regarding claims 1 and 10: Setchell discloses a system (figure 1 of Setchell) comprising means for displaying a reference image on a calibrated display device (figure 1(130); column 3, lines 28-30; and column 4, lines 31-34 of Setchell); means for instructing a subject to place a body part (whole body in figure 1(120) of Setchell) adjacent the reference image (figure 1(120); column 3, lines 29-30; and column 5, lines 52-58 of Setchell); means for capturing a calibrating image of the body part adjacent the reference image using an image capture device (figure 1(140); column 3, lines 29-30; and column 5, lines 52-58 of Setchell); means (figure 1(180(portion)) and column 4, lines 1-4 of Setchell) for generating calibration information (column 4, lines 36-42 of Setchell) by processing the calibrating image and information reflective of the reference image (column 4, lines 30-36 and lines 44-47 of Setchell); and means (figure 1(180(portion)) and column 4, lines 1-4 of Setchell) for calibrating at least one of the image capture device and a driver for the image capture device using the calibration information (column 4, lines 15-24 of Setchell). The generation of calibration information and the calibration itself is performed using image processing software (figure 2(250) of Setchell) physically embodied in a computer (figure 1(180) and column 4, lines 1-4 of Setchell). The means for generating and means for calibrating are each their respective portions of the physically embodied software.

Further regarding claim 1: The system of claim 10 performs the method of claim 1.

Regarding claims 19 and 29: Setchell discloses a system (figure 1 of Setchell) comprising means for providing a reference image to a subject (figure 1(130); column 3, lines 28-30;

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and column 4, lines 31-34 of Setchell); means for instructing the subject to place a body part (whole body in figure 1(120) of Setchell) adjacent the reference image (figure 1(120); column 3, lines 29-30; and column 5, lines 52-58 of Setchell); means for capturing a calibrating image of the body part adjacent the reference image using an image capture device (figure 1(140); column 3, lines 29-30; and column 5, lines 52-58 of Setchell) space away from the reference image (as clearly shown in figure 1 of Setchell); means (figure 1(180(portion)) and column 4, lines 1-4 of Setchell) for generating calibration information (column 4, lines 36-42 of Setchell) by processing the calibrating image and information reflective of the reference image (column 4, lines 30-36 and lines 44-47 of Setchell); and means (figure 1(180(portion)) and column 4, lines 1-4 of Setchell) for calibrating at least one of the image capture device and a driver for the image capture device using the calibration information (column 4, lines 15-24 of Setchell). The generation of calibration information and the calibration itself is performed using image processing software (figure 2(250) of Setchell) physically embodied in a computer (figure 1(180) and column 4, lines 1-4 of Setchell). The means for generating and means for calibrating are each their respective portions of the physically embodied software.

Further regarding claim 19: The system of claim 29 performs the method of claim 19.

Regarding claims 2, 11, 20 and 30: Setchell discloses that the reference image (figure 1(130) of Setchell) includes a color bar of multiple colors and a swatch of multiple colors (column 4, lines 30-36 of Setchell). Each column and/or each row is a

color bar of multiple colors. The entire 2-dimensional set of patches is a swatch of multiple colors.

Regarding claims 3, 12, 21 and 31: Setchell discloses that the color represent at least one of skin tone, skin color, and skin replica (column 5, lines 52-56 of Setchell).

Regarding claims 4 and 13: Setchell discloses that means for displaying a reference image includes means for providing access to at least one of a client-based algorithm and a server-based algorithm for displaying the reference image (column 3, lines 32-40 of Setchell). Software embodied on a local computer system is clearly a client-based algorithm.

Regarding claims 6, 15, 24 and 34: Setchell discloses that means for capturing a calibrating image includes providing access to at least one of a client-based algorithm and a server-based algorithm for causing the image capture device to capture a calibrating image (column 3, lines 32-40 of Setchell). Software embodied on a local computer system is clearly a client-based algorithm.

Regarding claims 7, 16, 25 and 35: Setchell discloses that means for generating calibration information included means for comparing at least one color of the body part in the calibrating image and at least one color of the reference image (column 4, lines 44-47 and column 5, lines 52-56 of Setchell).

Regarding claims 8, 17, 26 and 36: Setchell discloses that means for calibrating includes means for enabling an adjustment on a subsequent captured image based upon the calibration information (column 4, lines 15-24 of Setchell). Since the calibration is performed based on a best match of two profile connection spaces (column 4, lines 15-24 of Setchell), any and all image data thus processed between the same two profile

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connection spaces (column 4, lines 1-14 of Setchell) will be calibrated such that the colors of the scanner and the colors of the printer will match (column 4, lines 15-24 of Setchell).

Regarding claims 22 and 32: Setchell discloses that means for providing a reference image includes one of means for electronically transmitting the reference image and means for physically transmitting the reference image (figure 1(120); column 3, lines 28-29; and column 4, lines 30-32 of Setchell). As can be seen from figure 1 of Setchell, the reference image is physically transmitted.

Regarding claims 28 and 38: Setchell discloses that the means for providing a reference image comprises means for enabling the subject to obtain the reference image in hard copy form via a printer (figure 1(195) and column 4, lines 19-24 and lines 30-32 of Setchell).

Regarding claim 39: Setchell discloses enabling a subject to print a reference image (figure 1(130) and column 3, lines 28-30 of Setchell) on a calibrated printer (column 3, lines 35-40 of Setchell); instructing a subject to place a body part (whole body in figure 1(120) of Setchell) adjacent the printed reference image (figure 1(120); column 3, lines 29-30; and column 5, lines 52-58 of Setchell); capturing a calibrating image of the body part adjacent the printed reference image (figure 1(140); column 3, lines 29-30; and column 5, lines 52-58 of Setchell); generating calibration information (column 4, lines 36-42 of Setchell) by processing the calibrating image and the reference image (column 4, lines 30-36 and lines 44-47 of Setchell); and calibrating at least one of an image capture device and a driver for the image capture device using the calibration information (column 4, lines 15-24 of Setchell).

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5, 14, 23 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Setchell (US Patent 6,836,345 B1) in view of well-known prior art.

Regarding claims 5, 14, 23 and 33: Setchell discloses instructing a subject to place a body part (whole body in figure 1(120) of Setchell) adjacent the reference image (figure 1(120); column 3, lines 29-30; and column 5, lines 52-58 of Setchell).

Setchell does not disclose expressly that instructing the subject includes at least one of transmitting instructions to the subject over a network, transmitting instructions to the subject in the form of software, and instructing the subject via hard-copy form of instructions.

Official Notice is taken that transmitting instructions to the subject over a network, transmitting instructions to the subject in the form of software, and instructing the subject via hard-copy form of instructions are all old, well-known and expected in the art. One of ordinary skill in the art at the time of the invention would have been motivated to instruct the subject, as taught by Setchell, specifically by one of transmitting instructions to the subject over a network, transmitting instructions to the subject in the form of software, and

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instructing the subject via hard-copy form of instructions since the instructions need to be relayed to the subject in some form and each of the three above ways of relaying instructions are common and ordinary means of relaying instruction.

8. Claims 9, 18, 27 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Setchell (US Patent 6,836,345 B1) in view of Beall (US Patent 4,693,255).

Regarding claims 9, 18, 27 and 37: Setchell discloses means for capturing an image using said at least one calibrated image capture device and driver (figure 1(190) and column 3, lines 34-40 of Setchell).

Setchell does not disclose expressly means for providing a beauty analysis based upon the captured image.

Beall discloses means for providing a beauty analysis (column 5, lines 45-57 of Beall) based upon a captured image (column 4, lines 18-22 and column 5, lines 5-10 of Beall). Clearly, the level of skin burn severity directly affects the beauty of the patient under consideration.

Setchell and Beall are combinable because they are from the same field of endeavor, namely determination and matching of sets of color image data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the color matching system of Setchell to analyze burn severity, and thus beauty, according to the teachings of Beall. The suggestion for doing so would have been that the system of Setchell matches colors and the system of Beall has a specific medical utility which functions based on the matching of color data patterns. Therefore, it would have been obvious to combine

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Beall with Setchell to obtain the invention as specified in claims 9, 18, 27 and 37.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Rigg et al., US Patent 5,785,960, Patented 28 July 1998. This reference teaches dermatological analysis, with the results sent either electronically or by post.
- b. Bhattacharjya et al., US Patent 6,546,132 B1, Patented 08 April 2003, Filed 21 September 1999. This reference teaches calibrating a printer and a scanner to match specific colors, such as skin tones.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Thompson
Examiner
Art Unit 2624



14 December 2005



THOMAS D. LIFE
JANUARY EXAMINER